



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/880,755      | 06/15/2001  | Olivier Marce        | Q64933              | 5934             |

7590

03/12/2004

SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC  
SUITE 800  
2100 Pennsylvania Avenue, N.W.  
Washington, DC 20037-3213

EXAMINER

FOX, BRYAN J

ART UNIT

PAPER NUMBER

2686

DATE MAILED: 03/12/2004

4

Please find below and/or attached an Office communication concerning this application or proceeding.

PM

# Office Action Summary

Application No.

09/880,755

Applicant(s)

MARCE ET AL.

Examiner

Bryan J Fox

Art Unit

2686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

## A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3/6-12-01.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 7 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 7 recites the limitation "the user" in the last 2 lines of the claim 1 and the last line of claim 7. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4 and 7-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Brohoff (US006108533A).

Regarding claims 1 and 7, Brohoff discloses a system for providing geographic information from a database within a radio telecommunications network where an MSC 18 includes a geographic database that may be searched and accessed by mobile

station 19 in the cellular system (see column 4, lines 4-9 and figure 1), which reads on the claimed "method of accessing from a mobile telephone one of a set of services stored in a telecommunication network associated with said mobile telephone, in which said service is determined by the geographical location of said mobile telephone". The mobile telephone inputs a search key as well, which reads on the claimed "short-code number". The search-key must be supplied to the user of the mobile telephone if it is to be used because if the user does not know the search key, of course he cannot use it.

Regarding claims 2 and 8, Brohoff discloses that the input to the geographic database typically includes two components: the geographic area from which the inquiry originates and a search key designating information a user desires to obtain from within the database (see column 4, lines 12-17), which reads on the claimed supplying of "said short-code number and information relating to said geographical location of said telephone". Since the database is not contacted directly from the mobile phone, but instead through the MSC connected to the base station associated with the phone (see column 4, lines 1-9), this information must be supplied to the database by the base station, which reads on the claimed "control station to which said mobile telephone is connected", and the MSC associated with the database which the information is supplied to reads on the claimed "centralized manager associated with a central database".

Regarding claims 3 and 9, Brohoff discloses that the geographic area from which the inquiry occurs could be the cell from which the service is invoked by a mobile station

(see column 4, lines 17-19), which reads on the claimed "information relating to location is an identifier of said control station".

Regarding claims 4 and 10, the database is associated with an MSC and as is well known in the art there are multiple MSC's in a mobile system, each associated with a certain geographic region, which reads on the claimed "said services are stored in a local database associated with said control station to which said mobile telephone is connected".

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 5, 6, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brohoff in view of Michaels et al. (US006011976A).

Regarding claims 5, 6 and 11 and 12, Brohoff fails to teach that a short code is sent to the user in an SMS message.

Michaels et al. discloses a wireless telecommunications system where informational messages can be sent to a user based on the users location, and the message includes a telephone number of an advertiser (see column 3, lines 6-9).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Brohoff with Michaels et al. to include the above sending of telephone numbers to the user in order to allow a vendor to alert users of valuable information offered.

Regarding claim 6 and 12, Brohoff fails to teach the use of a profile so that only services matching the user are transmitted to the user.

Michaels et al. discloses that the SIM card can be trained only to receive messages detailing services relevant to a subscriber's needs (see column 6, lines 34-36), which reads on the claimed invention that only transmits numbers corresponding to services matching a user profile.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Brohoff with Michaels et al. to include the above selective receiving of messages in order to prevent the user from receiving too many messages in which he has no interest.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hyziak et al. (WO 93/17504) discloses a method and apparatus for providing a point -and-address communication system.

Richton (US006650902B1) discloses a method and apparatus for wireless telecommunications system that provides location-based information delivery to a wireless mobile unit.

Morrissey et al. (US005418844A) discloses automatic access to information service providers.

Hetz et al. (US006185289B1) discloses mediated AIN control of short code access to information service providers.

Michaels et al. (US006011976A) discloses a telecommunications system with value added service directory and an integrated circuit module therefor.

Mercer et al. (US006167429A) discloses a service access using limited set of characters.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryan J Fox whose telephone number is (703) 305-8994. The examiner can normally be reached on Monday through Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on (703) 305-4379. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BJF

*Nguyen Vo*  
*3-8-2004*

**NGUYENT.VO  
PRIMARY EXAMINER**